

REMARKS

I. General Remarks

Prior to the above amendment, claims 1 and 3 were pending, and claim 2 was cancelled. The Examiner finally rejected the pending claims on July 12, 2006. Applicants appealed this rejection to the Board of Patent Appeal and Interferences ("the Board") on March 15, 2007. On July 22, 2009, the Board issued a Decision on Appeal.

In its decision, the Board upheld the Examiner's position that the cited reference Sunagawa (European Patent No. EP 0 994 125 A1) supports a § 102(b) rejection of claims 1 and 3. *See* Decision on Appeal, page 5. 37 C.F.R. § 41.50(b) allows Applicants to 1) request rehearing under 37 C.F.R. § 41.52, or 2) reopen prosecution. Applicants hereby re-open prosecution of this application to respond to the Board's rejection.

II. Status and Disposition of the Claims

By this Amendment, claims 1 and 3 are amended to more specifically point out and distinctly claim what Applicants consider the invention. Support for the amendment can be found, for example, in the original claims. New claims 4-8 are added. Support for the new claims can be found throughout the specification, including, for example, paragraphs [0037] - [0045] in U.S. Patent Publication No. 2004/0161668, which is the U.S. patent publication of the pending application (hereinafter "the '668 publication").

This Amendment introduces no new matter. After the entry of new claims, claims 1 and 3-8 will be pending. Applicants respectfully request prompt examination of the pending claims.

III. Response to Claim Rejection

The Board's Decision alleges that Applicants conceded "that Sunagawa's and Appellants' compositions are the same." See Decision on Appeal, page 3. Applicants respectfully submit that this statement mischaracterizes Applicants' position. Applicants have never considered the composition disclosed in Sunagawa to be the same as the composition defined by Applicants' claims. The following excerpt from the Appeal Brief clearly demonstrates Applicants' position on this point.

In view of the data presented in Table 1 of the specification, Appellants submit that even if, *arguendo*, the lithium composite oxide of Sunagawa is considered to fall within the scope of the compositional elements recited in claims 1 and 3, this similarity in composition **is not** sufficient to establish that Sunagawa's lithium composite oxide **necessarily** possess the claimed lithium site occupancy rate and difference in specific surface area. Indeed, as shown in Table 1, **identical compositions** exhibit these properties to widely varying degrees. Appellants again submit, however, that "inherency...**may not** be established by probabilities or possibilities. The mere fact that a certain thing **may** result from a given set of circumstances is **not** sufficient" to establish inherency. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (emphasis strongly added). Appeal Brief at 11-12.

Based on the mischaracterization that Sunagawa's and Applicants' compositions are the same, the Board shifted the burden to Applicants to show that "Sunagawa's composition does not possess the Li site occupancy rate and difference in specific surface area." See Decision at 4. However, established legal precedent only permits that "the PTO can require an applicant to prove that the prior art products do not **necessarily or inherently** possess the characteristics of his [or her] claimed product." MPEP 2112 III. Emphasis added. Applicants respectfully submit that the Board

impermissibly raised the well-established burden of proof for rebutting a prima facie anticipation rejection.

Nevertheless, in order to advance prosecution, Applicants have amended claims 1 and 3 by adding limitations that further distinguish the claimed invention from Sunagawa. Namely, Applicants have further specified that the active material in claim 1 is "optionally subject to a washing process so that the difference between the specific surface area of the active material before the washing process and after the washing process is $1.07 \text{ m}^2/\text{g}$ or less." Nowhere does Sunagawa disclose a washing process for the active material. For at least this reason, Sunagawa does not anticipate claim 1, as amended.

Likewise, claim 3 incorporates all claim limitations in claim 1, and therefore is not anticipated by Sunagawa. Applicants further submit that new claims 4-8 are also patentable over Sunagawa.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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